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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,096	11/13/2001	Joachim Blum	FA-1035	7509

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,096

Applicant(s)

BLUM ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-13, 15-27 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13, 16-24, 26 and 29-37 is/are rejected.
- 7) ☒ Claim(s) 15, 25 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/20/2004 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed in the above-mentioned submission, with respect to the rejections based on Wade set-forth in the Office action mailed 5/18/2004, have been fully considered and are persuasive. Applicant has declared that the lacquer of the claimed invention does not encompass an adhesive. In other words, applicant has declared that, in so much as the term lacquer could be construed to encompass adhesives, applicant disclaims adhesives (see page 9 of the above-mentioned response). Consequently, in keeping with the position of the examiner set-forth in the record to date, because Wade discloses adhesives, these rejections have been withdrawn.

3. Applicant's arguments filed in the above-mentioned submission, with respect to the rejections based on Yaver set-forth in the Office action mailed 5/18/2004, have been fully considered but they are not persuasive.

Applicant argues that, because Yaver discloses an embodiment in which the transparent or translucent core is abraded or embossed, this reference does not teach the claimed smooth, high-gloss rear surface. The examiner disagrees. While the abrading/embossing embodiment

may be the preferred one, patents are relevant for all that they contain and a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. See MPEP § 2123. As noted in prior actions, Yaver discloses that “[t]he opaque layer may also be simply a painted or printed layer” (3:61-62). Because Yaver explicitly discloses an embodiment in which the core is abraded/embossed and then coated with opacifying ink (3:56-61), the juxtaposition of this embodiment with the one above fairly teaches simply painting or printing the opaque layer on the core, without abrading/embossing.

The examiner notes that the phrase “smooth, high-gloss” is not explicitly defined in the specification. In other words, the terms “smooth” and “high” are relative terms and the specification fails to define what degrees of smoothness and glossiness satisfy applicant’s claimed “smooth, high-gloss surface.” Applicant’s line of argument appears to suggest that the non-abraded/embossed rear surface of Yaver satisfies applicant’s claimed “smooth, high-gloss surface,” insofar as applicant relies on this feature to distinguish the claimed invention over Yaver. In any event, it is the examiner’s position that the substrate of Yaver inherently possesses some degree of smoothness and gloss, thereby satisfying this limitation until the extent of smoothness and glossiness required can be properly established.

Further, the examiner presents new grounds of rejection below establishing that it would have been obvious to use a plastic core having a smooth, glossy surface in the article/method of Yaver. In this regard, it is noted that applicant argues that Yaver’s abrading/embossing embodiment “on its face expressly teaches away from applicant’s claimed invention.” Again,

the examiner disagrees. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. See MPEP § 2123.

Consequently, applicant's arguments vis-à-vis Yaver are not persuasive.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 10-13, 15-27, and 29-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The terms "smooth" and "high-gloss" in claims 10, 13, 31, 33, 35, and 37, is a relative term which renders the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what degree of smoothness and glossiness the rear surface must possess to be considered smooth and high-gloss. Further it is unclear by what standard or measurement such values are established. *All* transparent plastic surfaces inherently possess some degree of smoothness and glossiness and it is unclear which surfaces are included/excluded by the claim.

Claims 12, 15-27, 29, 30, 32, 34, and 36 are similarly indefinite by virtue of their dependence from the above-cited claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 10-13, 16-19, 21-24, 26, 29-31, 33, 35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Yaver (US 4,877,657 A).**

Yaver teaches a decorative vehicle trim part (abstract and 2:45-55). The part comprises a transparent plastic core 11 having front and rear faces with an opaque lacquer layer disposed directly on the rear face and a transparent film overlay disposed on the front face (cc. 3 – 4). As noted above, this reference fairly teaches an embodiment in which the rear surface is not abraded (3:56-62). Further, as noted above, all transparent plastic surfaces inherently possess some degree of smoothness and gloss, which the examiner interprets as satisfying the claim until the extent of smoothness and glossiness required can be properly established.

With specific respect to claims 16, 17, 31, 33, and 35, the rear face may or may not be pre-treated with an adhesion-promoting primer prior to application of the opaque lacquer layer (3:46-63 and 5:45-46).

With respect to claim 19, Yaver teaches that the plastic core 11 may contain dyes (3:9-15).

With specific respect to claims 21 and 22, the plastic core 11 may be a polyester, acrylonitrile/butadiene/styrene terpolymer, or acrylic film (3:2-15).

With specific respect to claims 26 and 29, Yaver discloses one particular embodiment in which a tinted transparent film is applied to the front face (5:1-19).

***Claim Rejections - 35 USC § 103***

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 20, 32, 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaver (US 4,877,657 A).**

With respect to claim 20, it is the examiner's position that the auxiliary substances recited in this claim are common and well-known additives for plastic and/or lacquer compositions. Consequently, it would have been obvious to one of ordinary skill in the art to include one or more of them in the plastic and/or lacquer compositions of Yaver.

With respect to claim 32, it is the examiner's position that the recited treatments are well-known in the art for improving adhesion of coatings to plastic substrates. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Yaver to utilize one or more of these treatments to improve the adhesion of the coating to the plastic core.

With respect to claims 34 and 36, Yaver does not explicitly teach that the color and/or effect producing lacquer layer 30 has a thickness of 10 to 30 micrometers. It is the examiner's position that the thickness of Yaver's opaque lacquer layer is a result-effective variable, effecting the adhesion and thickness of the overall plastic part. Absent clear and convincing evidence of unexpected results demonstrating the criticality of the claimed thickness range, it would have been obvious to one of ordinary skill in the art to optimize such a result-effective variable by routine experimentation. See MPEP § 2144.05(II).

**11. Claims 10-13, 16-24, 26, and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaver (US 4,877,657 A) in view of James (US 3,113,883 A).**

Yaver is applied again here as set-forth above.

As noted above, Yaver does not explicitly state that the plastic core has a smooth, high-gloss rear surface.

Yaver teaches that the plastic core may be made of a variety of materials, optimally formed through extrusion, though other plastic processing techniques can be used (3:2-15). It is the examiner's position that at this suggestion, one of ordinary skill in the art would have looked to the prior art to find a suitable extrusion or other processing technique to provide the plastic core.

James teaches a process for the production of transparent films of the several of the plastic materials disclosed by Yaver (1:58-63 and 2:66-3:1). The process includes processing the film with the "smooth and glossy arcuate surfaces" of rollers, which impart such a surface to the film (3:19-33; 4:55-58; and 5:20-22).



It would have been obvious to one of ordinary skill in the art to modify the article/process of Yaver so as to provide the transparent core having a smooth and glossy surface according to the technique of James. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of providing a suitable transparent plastic core for the article/process, as suggested by both Yaver and James.

### ***Allowable Subject Matter***

12. Claims 15, 25, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, as well as overcoming the rejections under 35 U.S.C. 112, 2<sup>nd</sup> Paragraph, set-forth above.

13. The following is a statement of reasons for the indication of allowable subject matter: Yaver is clear that the front face be a clear plastic overlay (4:23-55). It is clear from this disclosure that Yaver's front face be free from distortion, effect, or opacity that would otherwise inhibit viewing the design on the rear face.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*WPF 12/8/2004*

William P. Fletcher III

Examiner

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